


1103326-0203 CON**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**RECEIVED
CENTRAL FAX CENTER

JUL 21 2006

Applicants : Lundberg et al.
Serial No. : 10/693,317
Filed : October 23, 2003
For : NEW PHARMACEUTICAL FORMULATION
AND PROCESS
Examiner : Sheikh, Humera N.
Group Art Unit : 1615

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8	
I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on July 21, 2006 at the facsimile number 571-273-8300.	
<u>John M. Genova</u>	<u>32,224</u>
Attorney Name	PTO Reg. No.
	<u>21 July 2006</u>
Signature	Date of Signature

MAIL STOP PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pages: 2

**Request for Reconsideration
of
Petition for Suspension of Prosecution under 37 C.F.R. §1.103**

Sir:

On April 27, 2006, Applicants filed a Petition for Suspension of Prosecution ("Petition") under 37 C.F.R. §1.103 as part of an Amendment in response to the Office Action, mailed November 2, 2005. The Petition fee of \$200.00 was paid. On July 12, 2006, a Decision was issued denying the Petition on the following grounds:

- (a) it is insufficient to merely state that a pending court decision is pertinent to the prosecution of the application without identifying issues or reasons why such court decision would impact the prosecution of the application, and
- (b) a Notice of Non-Compliant ("Notice"), mailed July 7, 2006, was allegedly pending at the time of issuance of the Decision.

07/24/2006 TL0111 00000079 231703 10693317
01 FC:1463 200.00 DA

USSN10/693,317, filed October 23, 2003
Attorney Docket No. 1103326-0203 CON
Page 2 of 2

With regard to ground (b), a response to the Notice was filed July 13, 2006, i.e., one day after the issue date of the Decision and before receipt thereof by the undersigned Attorney. Thus, ground (b) for denying the Decision is moot.

The Office Action indicates that claims 1, 3, 6 and 8-19 of the subject application are allowed. The Amendment is responsive to the objections and rejections as set forth in Office Action with respect to the remaining claims and, therefore, it is reasonably expected that the Amendment will advance the application to allowance. As discussed in an Information Disclosure Statement, filed December 7, 2004, claims 1-3, 7, 16, 20 and 21 of the great-great-grandparent of the subject application, i.e., US 6,013,281 (the "281 patent"), were found to be invalid in view of the same prior art that is presently before the Examiner. An appeal of the court's decision, including a cross-appeal, regarding the holding of invalidity of claims 1-3, 7, 16, 20 and 21 of the '281 patent, docketed as Astra Aktiebolag v. Andrx Pharma., Nos. 04-1562, -1563, -1589, is presently pending before the Court of Appeals for the Federal Circuit.

There is an overlap between the pending claims of the subject application and claims of the '281 patent which were found to be invalid. Therefore, in view of the totality of the circumstance, it behooves both the Office and Applicants in their shared public duty to ensure the issuance of valid patents to await an outcome of the appeal before proceeding with the prosecution of the subject application, especially when there is a discrepancy regarding the patentability of claims in the face of the same prior art. Furthermore, waiting for an outcome of the appeal will enable the Office and Applicants to make an informed decision regarding the expenditure of their respective resources before resuming prosecution.

In view of the foregoing, Applicants respectfully request withdrawal of the negative Decision and a grant of the Petition.

The Petition fee of \$200.00 was paid. Any fee other required in connection with this communication may be charged to Deposit Account No. 23-1703 .

Dated: July 21, 2006

Respectfully submitted,



John M. Genova

Reg. No. 32,224

Customer No. 007470

Attorney Direct Dial: (212) 819-8832